



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,701	09/25/2003	Takeshi Koyama	2003-1261A	6365

513 7590 08/25/2006

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/669,701	Applicant(s) KOYAMA ET AL.	
	Examiner Chukwuma O. Nwaonicha	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8-11 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 21 July 2006.
2. Claims 1-33 are pending in the application.
3. The rejection of claims 14-21 under 35 U.S.C 102, as being anticipated by Brytus set forth in the previous Office Action of 3/21/06 is withdrawn following applicants' amendments. Applicants have amended the claims to overcome the 102 rejection. The instant claims are not anticipated nor rendered obvious by Brytus.
4. The allowability of claims 8-11 is maintained.
5. The allowability of claims 27-33 is withdrawn for the reason given below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 and 27-33 are indefinite because it is not clear which cyclic aliphatic polyamine the applicant is claiming. It is required that applicants show the general structure of the cyclic aliphatic polyamine in claim 1 to allow the Examiner to examine the application correctly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

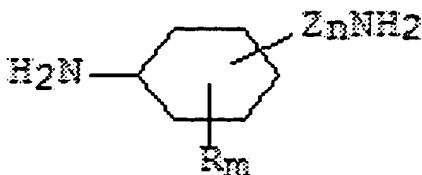
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao Soap Co., Ltd., {JP 58017452}.

Applicants claim a modified cyclic aliphatic polyamine having an ethyleneamino moiety which is obtained by addition reaction of a cyclic aliphatic polyamine and an alkenyl compound, wherein the number of carbon atoms in a molecule of the cyclic aliphatic polyamine is at least nine, the number of amino groups in a molecule of the cyclic aliphatic polyamine is at least two and the number of active hydrogen atoms derived from the amino groups is at least three; wherein all the variables are as defined in the claims.

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

Kao Soap Co., Ltd. teaches the compound of the general formula 1, wherein Z = C1-4 alkylene; R = C1-4 alkyl; n = 0-2 and m = 0-10.



formula 1

Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)

Kao Soap Co., Ltd. compound differs from the instantly claimed cyclic aliphatic polyamine in that Kao Soap Co., Ltd. disclosed cyclic aliphatic polyamine is a subgenus of applicants claimed cyclic aliphatic polyamine. Specifically, applicants claim cyclic aliphatic polyamine wherein the variables are as defined in the prior art cyclic aliphatic polyamine of Kao Soap Co., Ltd. See Abstract.

Finding of prima facie obviousness--rational and motivation (M.P.E.P. §2142-2143)

The instantly claimed cyclic aliphatic polyamine would have been suggested to one of ordinary skill because one of ordinary skill wishing to obtain a cyclic aliphatic polyamine for polyester resin is taught to select the cyclic aliphatic polyamine from the genus of Kao Soap Co., Ltd.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the substituents of the genus of Kao Soap

Co., Ltd. to arrive at the instantly claimed cyclic aliphatic polyamine. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that cyclic aliphatic polyamine is a useful industrial compound. The instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Wenning, {EP 972786}.

Wenning discloses applicant claimed compounds. See Abstract. Since Applicants have claimed a product by way of a product by process claim, the Examiner did not give any patentable weight to the process step.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Komoto et al., {JP 48036298}.

Komoto et al. disclose applicant claimed compounds. See Abstract. Since Applicants have claimed a product by way of a product by process claim, the Examiner did not give any patentable weight to the process step.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kao Soap Co., Ltd., {JP 58017452}.

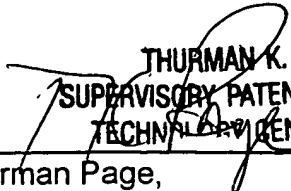
Kao Soap Co., Ltd., discloses applicant claimed compounds. See Abstract. Since Applicants have claimed a product by way of a product by process claim, the Examiner did not give any patentable weight to the process step.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.
Patent Examiner
Art Unit: 1621


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 1600
Thurman Page,